

Application No.: 10/774,795
Attorney Docket No.: 21480-0001-U1

D. AMENDMENTS TO THE DRAWINGS

There are no amendments to the drawings.

Application No.: 10/774,795
Attorney Docket No.: 21480-0001-U1

E. REMARKS

The present invention is directed to apparatus and methods for rolling of flexible fencing materials. The apparatus includes a unique combination of components which applicant believes are novel and non-obvious in light of prior art.

Status of the Claims

Claims 1 – 25 are pending in the subject application as of the Office Action dated December 15, 2005, with Claim 12 having been withdrawn from consideration as a result of a previous USPTO restriction requirement. By this amendment, claims 3 and 12 are canceled, and claims 1-2, 4-11 and 13-25 remaining pending. Applicant has amended the pending claims, and requests reconsideration of all pending claims by the Examiner in light of the previous rejection and this amendment.

35 U.S.C. 112 Rejections

The Examiner rejected claims 9, 17, and 18 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By this Amendment, Applicant has amended those claims to obviate the rejection. In particular, claim 9 has been amended to require "dynamic tensioning means" thereby specifying the function of tensioning so that equivalent means can be determined as required by 35 U.S.C. § 112, sixth paragraph. With respect to claims 17 and 18, Applicant has amended the claims as suggested by the Examiner to comply with that statutory section. For this reason, Applicant requests that the Examiner remove the rejection under 35 U.S.C. §112.

35 U.S.C. 103(a) Rejections

The Examiner has rejected claims 1-5, 7-11, 19-21 and 23-25 under 35 U.S.C. § 103(a). The text of the Examiner's rejection is as follows:

Claims 1-5, 7-11, 19-21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyer, Sr. (US-6042046) in view of Moon et al (US-5163634) and Frolander et al (US-6543713).

Application No.: 10/774,795
Attorney Docket No.: 21480-0001-U1

Beyer, Sr. discloses an apparatus having substantially all the claimed features including a motor 56 and a wrapping shaft 16. Beyer, Sr. does not explicitly disclose an end of the shaft to be removably connected to the motor and a tensioning roller. However, it is deemed inherent that the end of the shaft is removably connected (such as by unscrewing nuts, bolts, etc.) to the motor or, alternatively, to removably connect the motor and shaft would have been obvious to a person having ordinary skill in the art to facilitate maintenance and repair (i.e., such as to replace just the motor when the motor is inoperable). Moon et al discloses another similar apparatus in which a tensioning members 21 (21a can be cylindrical to minimize friction) and 35 (adjustably mounted) and guide 17 are provided. Frolander et al discloses another similar apparatus in which rollers 68 are used for a fence apparatus. It would have been obvious to a person having ordinary skill in the art to provide the apparatus of Beyer, Sr. with tensioning members and guide as taught by Moon et al to tension the elongated material and to provide the tensioning members as rollers as taught by Frolander et al to reduce friction and wear. Note the mounting plate holding shaft 28 and the lift mechanism of the motorized vehicle in Moon et al. It would have been obvious to a person having ordinary skill in the art to alternatively provide the reeling and unreeling apparatus of Beyer, Sr. with a mounting plate for mounting on a vehicle as taught by Moon et al to conveniently lift/lower the apparatus as desired or needed. Relative to claim 3, that the motor is at the opposite end of the wrapping shaft would have been an obvious matter of design choice to a person having ordinary skill in the art based on factors such as ornamental preference, design criteria, space optimization, and costs. The method of claims 19-22 and 23-25 are deemed inherent or obvious in the apparatus and method of Beyer, Sr. modified as above.

Applicant has reviewed the Examiner's arguments, and has fully considered the cited references. For the following reasons, Applicant believes that the pending claims, as amended, are neither anticipated nor made obvious by the cited prior art.

The following principle of law applies to all Section 103 rejections. MPEP 2143.03 provides, "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." (Emphasis added.) That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not found in any of the applied prior art, the rejection cannot stand. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Application No.: 10/774,795
Attorney Docket No.: 21480-0001-U1

That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. The examiner bears the burden of stating a *prima facie* case of obviousness - if claim limitations are not found in any of the applied prior art, the rejection cannot stand.

With respect to combining references that do have limitations, Section MPEP Section 2143.01 furthermore directs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." Hindsight reconstruction of a claimed invention is not permitted, especially where the cited prior art is lacking a claimed element, to sustain a rejection under 35 U.S.C. §103(a):

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." Dembiczak, 175 F.3d at 999; see also Ruiz, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight." Dembiczak, 175 F.3d at 999. Therefore, we have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000) ("Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."); In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) ("In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."). Teleflex v. KSR International, 04-1152 (CAFC 2005). Emphasis added.

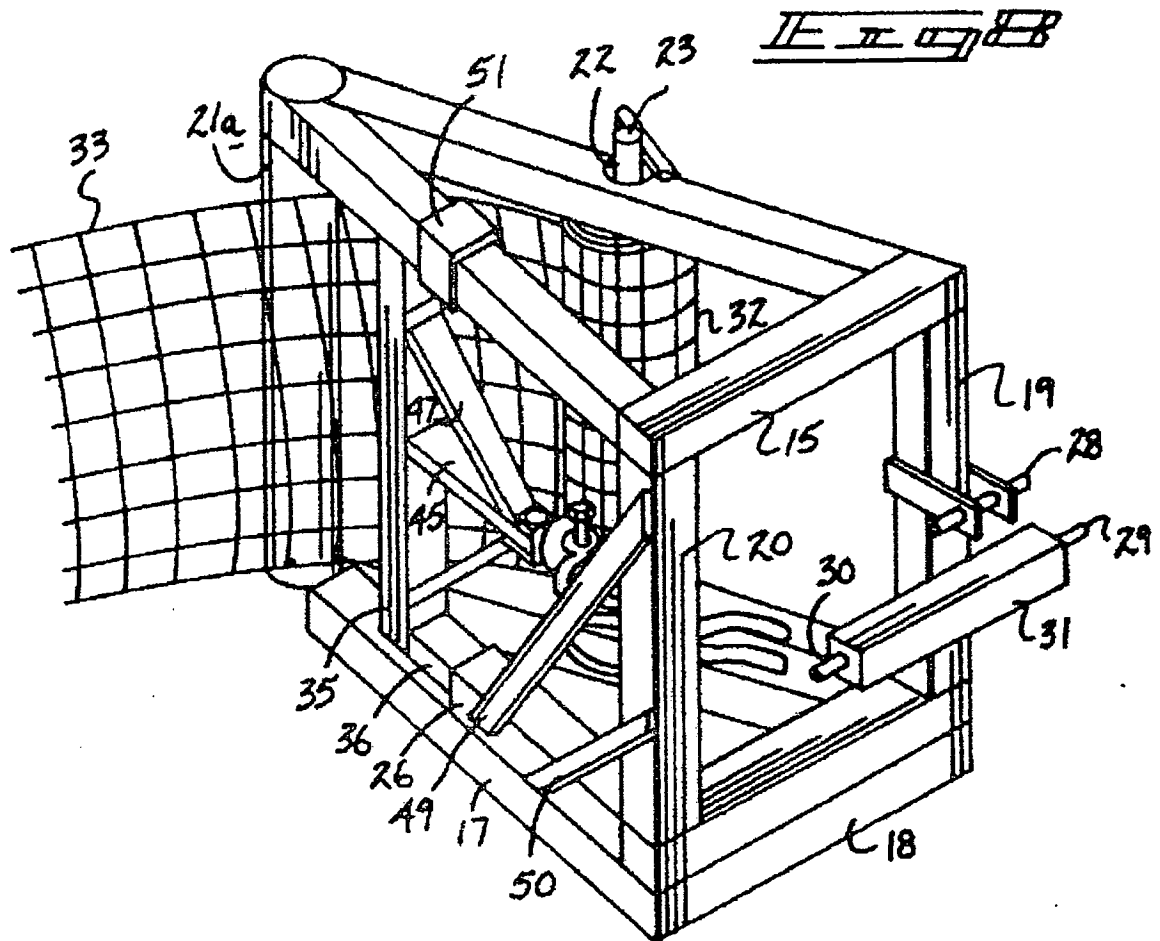
Applicant traverses the Examiner's rejection under 35 U.S.C. § 103(a), since it fails to state a *prima facie* case of obviousness as required by the applicable law and regulations cited

Application No.: 10/774,795
Attorney Docket No.: 21480-0001-U1

above. With respect to the rejection of claims 1-5, 7-11 and 23-25 under 35 U.S.C. § 103(a) over Beyer, Sr. in view of Moon et al and Frolander et al., Applicant submits that claim 1, as amended, includes limitations that are not taught by any of the cited references. In particular, none of the references teach the claimed requirement of least two opposed tensioning rollers that are rotatably and adjustably mounted to the supporting framework in substantially parallel orientation to a vertically mounted wrapping shaft. Applicant's tensioning rollers of claim 1 are explained, among other places, at Specification paragraph [0040]: "where two or more tensioning rollers are provided, tension can be applied during fencing distribution by increasing tension on the fencing passing between the tensioning rollers 40, such as by moving the tensioning rollers 40 closer together or by adjusting the rotational resistance through known means such as belts, rollers, and the like contacting the rollers 40."

While Beyer, Sr. teaches a vertical wrapping shaft, there is no mention or suggestion in Beyer, Sr. of any tensioning rollers, or any equivalent structure. Moon et al, as understood by Applicant after close review, teaches a wrapping apparatus having a framework that includes a "cylindrical leg guide leg 21a, as illustrated in FIG. 8" that "for example, may be used to minimize friction of the forward end of the fence wire roll 32 as it is directed across the guide leg." Col. 4, lines 7-10. See also Moon Fig. 8, pasted below:

Application No.: 10/774,795
 Attorney Docket No.: 21480-0001-U1



However, as evident from Fig.8, the "guide leg" of Moon et al is clearly not a rotatable cylinder, let alone a pair of opposed tensioning rollers, within the meaning of Applicant's claims. Rather, the guide leg 21a of Moon et al is a static member that may have a cylindrical edge to minimize friction. There is absolutely no suggestion in Moon et al of the guide leg being rotatably mounted, nor adjustable. In fact, as shown in Fig. 8, the cylindrical surface at the top of the cylindrical leg 21a appears to be fixed (e.g. welded) to the upper frame elements 15.

Frolander et al does not teach the missing prima facie elements of opposed tensioning rollers, and therefore does not cure the defects previously described with respect to the Examiner's rejection of claim 1. Frolander et al, as understood by Applicant, teaches a fence

Application No.: 10/774,795

Attorney Docket No.: 21480-0001-U1

rolling apparatus having a horizontally mounted wrapping shaft and supporting framework. Frolander et al teaches at FIG. 3 and at Col. 7, lines 49-51 "a plurality of vertical rollers 68 supported by the mounting bracket 66, and an actuator 70." See also Frolander Fig. 3, pasted below:

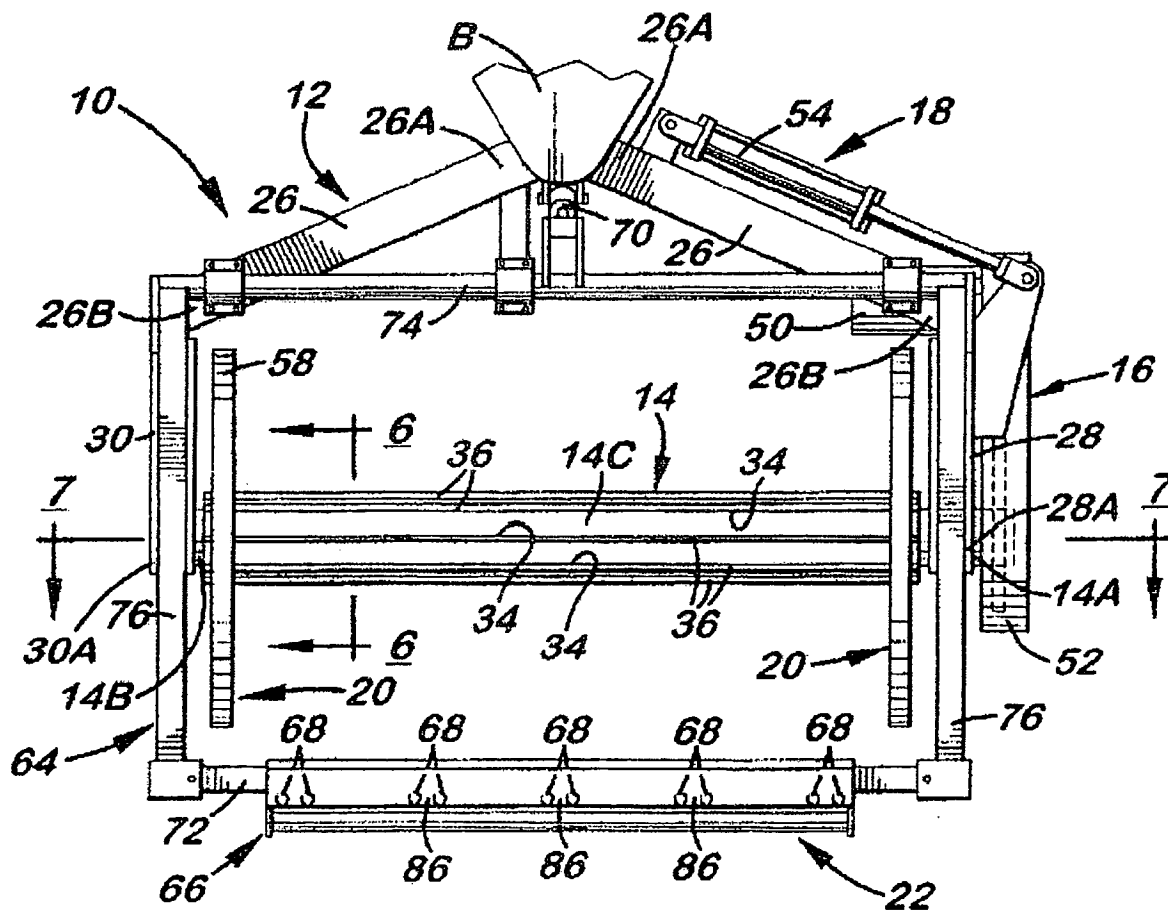


FIG. 3

Frolander et al states "The vertical rollers 68 of the wire guiding arrangement 22 are spaced apart from one another so as to define spaces 86 therebetween through which individual strands of barbed wire fence are guided to the drum 14." Col. 8, Lines 25-31. Additionally, Frolander et al makes no suggestion of the rollers providing any tension to, or pressure on, the

Application No.: 10/774,795

Attorney Docket No.: 21480-0001-U1

fencing by contacting and exerting force on the fencing as required in claim 1. In fact, the disclosed rollers taught by Frolander et al are provided for the entirely separate purpose of guiding individual wire strands, as evidenced by the specification and the figures that show the rollers mounted axially perpendicular to the wrapping shaft – similar to Applicant's support means. Additionally, as taught, Frolander et al's rollers are not compatible with screen-type fencing material as required by claim 1, since they are mounted axially perpendicular to the rotational axis of the wrapping shaft, and would prevent any orthogonal cross-strands of a screen-type fence from passing between them.

Thus, none of the cited references teach opposed tensioning rollers, let alone tensioning rollers that are rotatably and adjustably mounted. Therefore, no combination of those references will yield Applicant's claimed invention. Additionally, there is no motivation provided in the references to arrive at Applicant's combination, since none of the references describe or suggest the need for flattening of fencing that is a benefit of Applicant's invention, as described at Paragraph [0030] of the specification: "the tensioning roller(s) 40 exert pressure to flatten the [used] fencing to near-new condition, while also creating the tension necessary for tight wrapping." Since none of the references teach or suggest the problem solved by Applicant, the prima facie element of motivation is missing, and the rejection cannot be maintained. With all due respect, the Examiner has not met his burden of establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). Applicant submits that the rejection of independent claim 1, as well as dependent claims 2, 4-5, and 7-11 must therefore be withdrawn.

With respect to claim 6, which depends from amended claim 1, the Examiner has stated:

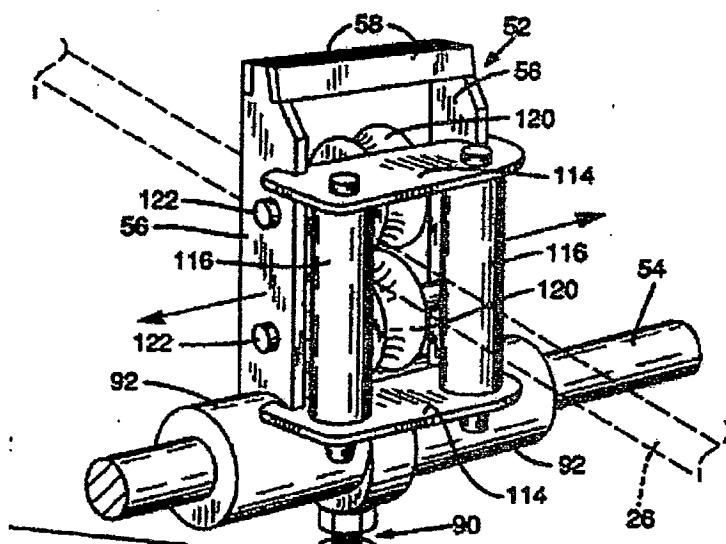
Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beyer, Sr. in view of Moon et al and Frolander et al as applied to claims 1-5, 7-11, 19-21, 23-25 above, and further in view of Hughes (US-5385314).

Hughes disclosed rollers support rollers 120 in conjunction with side rollers 116. It would have been obvious to a person having ordinary skill in the art to provide the apparatus of Beyer, Sr. modified as above with support rollers 120 as taught by Hughes to support the flexible material and guide it into the desired position.

Application No.: 10/774,795

Attorney Docket No.: 21480-0001-U1

The Examiner's rejection of claim 6 based on Beyer, Sr., Moon et al, and Frolander et al. in view of Hughes is traversed. If claim 1, as amended, is not obvious, then dependent claim 6 cannot be obvious. Additionally, Hughes does not add the missing prima facie elements of opposed rotatably and adjustably mounted tensioning rollers of claim 1, or the benefit of flattening fencing, as previously discussed. As shown in FIG. 1 of Hughes, the support rollers 120 are opposed, but are not provided for (or capable of) tensioning fencing. See Hughes Fig.1, pasted below:



In fact, as shown, the Hughes rollers 120 include opposed concave surfaces that form a passageway for wire strands to pass through. In contrast, as shown in FIGS. 11-14 and required in claim 1, Applicant's cylindrical tensioning rollers each have a convex surface that squeezes fencing passing between the rollers, thereby tensioning and flattening the fencing. In short, Hughes rollers are not equivalent in structure or function to Applicant's claimed opposed tensioning rollers. There is no suggestion in Hughes to provide tensioning rollers as claimed in claim 1, and no suggestion of flattening fencing. The side rollers 116 are also not tensioning rollers, since they are neither adjustable nor oppositely mounted to exert pressure on any fencing passing between them. Indeed, if any of the rollers as taught by Hughes were utilized in combination with the teachings of Beyer, Sr., Moon et al, and Frolander et al, the result would

Application No.: 10/774,795
Attorney Docket No.: 21480-0001-U1

render Applicant's invention inoperable. In any case, the combination would not yield Applicant's claimed invention.

For the above reasons, as well as the prior arguments concerning claim 1, Applicant requests that the Examiner remove the rejection of claim 6 under 35 U.S.C. §103(a).

The Examiner further rejected claims 13-18 under 35 U.S.C. 103(a) as being unpatentable over Beyer, Sr. in view of Moon et al and Frolander et al as applied to claims 1-5, 7-11, 19-21, 23-25 above, and further in view of Smith et al (US-5582216). The Examiner stated:

Smith et al discloses another similar apparatus in which retaining means including elements 73 are inserted into apertures 72 in the wrapping shaft to support disks 12 to adjustably support the flexible materials. It would have been obvious to a person having ordinary skill in the art to alternatively provide the wrapping shaft of Beyer et al with means as taught by Smith et al to adjustably support the flexible materials.

Smith does not add the missing prima facie elements of opposed rotatable adjustable tensioning rollers, or any motivation of flattening fencing, as previously discussed. Moreover, Claims 13-18 depend, directly or indirectly, from independent claim 1, as amended. If claim 1, as amended, is not obvious, then dependent claims 13-18 cannot be obvious. For the above reasons, as well as the prior arguments concerning claim 1, Applicant requests that the Examiner remove the rejection of claims 13-18 under 35 U.S.C. §103(a).

With respect to claims 19-21, and 23-25, Applicant has amended independent claims 19 and 23 to incorporate the limitations of claim 1, as amended. Therefore, for all the reasons stated above with respect to claim 1, it is respectfully submitted that the Examiner's rejection of independent claims 19 and 23, cannot be maintained.

Additionally, since the limitations of independent claims 19 and 23, as amended, are not made obvious by the cited art, it is submitted that dependent claims 10-21 and 23-25 are also not made obvious. Therefore, the rejection of claims 19-21 and 23-25 must be withdrawn.

Application No.: 10/774,795
Attorney Docket No.: 21480-0001-U1

Lastly, the Examiner rejected claim 22 under 35 U.S.C. 103(a) as being unpatentable over Beyer, Sr. in view of Moon et al and Frolander et al as applied to claims 1-5, 7-11, 19-21, 23-25 above, and further in view of Mikelionis (US-6503326). The Examiner stated:

Rolls of folded flexible materials to reduce roll widths are old and well known in the art as evidenced by Mikelionis. It would have been obvious to a person having ordinary skill in the art to fold the flexible material before winding to reduce roll widths as is old and well known and evidenced by Mikelionis.

Claim 22 depends from independent claim 19, as amended. For the above reasons, as well as the prior arguments concerning claim 1, Applicant submits that since claim 19, as amended, is not made obvious by the cited prior art, claim 22 is also not obvious. Additionally, Applicant has reviewed Mikelionis, which relates to toilet paper dispensing. Mikelionis does not add the missing prima facie elements of opposed rotatable and adjustable tensioning rollers, or any motivation of flattening fencing, as previously discussed.

Moreover, Applicant believes that the combination of Mikelionis, with Beyer, Sr., Moon et al and Frolander et al. is not motivated or suggested by any of the references. Mikelionis is neither in Applicant's field of endeavor, nor reasonably pertinent to the particular problem with which the invention was conceived. See MPEP 2141.01(a). None of the problems addressed by Applicant's invention would be addressed or even contemplated by the Mikelionis reference. No person skilled in the relevant art of fence rolling apparatus would combine the non-analogous teachings of Mikelionis. Applicant therefore requests that the Examiner remove the rejection of claim 22 under 35 U.S.C. §103(a).

Since support for every element in the claims, as amended, can be found in the original filed specification and figures, Applicant submits that no new matter is entered as a result of this Response and Amendment.

Application No.: 10/774,795
Attorney Docket No.: 21480-0001-U1

F. CONCLUSION


In view of the above, Applicant respectfully requests entry of this amendment, reconsideration of the Application and withdrawal of the outstanding rejections. As a result of the amendments and remarks presented herein, Applicant respectfully submits that independent claims 1, 19, and 23, as amended, are neither anticipated by the cited prior art nor rendered obvious.

As the independent claims are not anticipated by nor rendered obvious in view of the applied art, Applicant requests withdrawal of the outstanding rejections and allowance of dependent claims 2, 4-11, 13-18, 20-22, and 24-25. Thus, claims 1-11, and 13-25 are all believed to be in condition for allowance, and prompt allowance of those claims is respectfully requested.

If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact applicant's attorney at the phone number listed below. The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
McNEES WALLACE & NURICK LLC

By



Andrew L. Oltmans
Reg. No. 56,074
100 Pine Street, P.O. Box 1166
Harrisburg, PA 17108-1166
Tel: (717) 237-5281

Dated: March 13, 2006
Fax: (717) 237-5300